



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,525	10/11/2005	Katsu Kondo	KPO-SUN-P4/SN-89/US	4420
44702 7590 02/22/2010 OSTRAGER CHONG FLAHERTY & BROITMAN PC 570 LEXINGTON AVENUE FLOOR 17 NEW YORK, NY 10022-6894			EXAMINER STULII, VERA	
			ART UNIT 1794	PAPER NUMBER
			NOTIFICATION DATE 02/22/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jbroitman@ocfblaw.com
lmurrell@ocfblaw.com
dflaherty@ocfblaw.com

Office Action Summary	Application No. 10/552,525	Applicant(s) KONDO ET AL.	
	Examiner VERA STULII	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2009 and 01/26/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 19-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 19-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 19-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 31 recites a process for producing food and beverage, wherein the recited method steps are a) obtaining a collection of malt sprouts and b) immersing a collection of a of malt sprouts in a liquid. Claims 32 and 33 further recite using an immersion liquid to produce a food or beverage product. The claims are vague as to how the food and/or beverage is made. Obtaining an immersion liquid will not result into the production of food and/or beverage. Some other active steps of production of food and/or beverage appear to be needed. It is also not clear how the same method steps could lead to a production of food and beverage at the same time.

To expedite prosecution, claims would be construed as reciting a method of producing a food or alternatively a beverage product comprising the step of “using” the immersion liquid.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17, 19- 20, 24-26 and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Todorova et al.

In regard to claims 30 and 31, Todorova et al disclose a process for producing beverage products, using uncrushed malt sprouts (Abstract, p. 17). In regard to claims 17 and 31, since claim 17 recites that the malt sprouts of controlled particle size can be either uncrushed or crushed, therefore uncrushed malt sprouts disclosed by Todorova et al meet applicant's definition of having controlled particle size, and thus Todorova's uncrushed malt sprouts would also inherently read on a "controlled particle size". In regard to claim 31 and 19, Todorova et al disclose a process for producing beverage product comprising the further step of immersing the malt sprouts in a liquid to allow components of the malt sprouts to seep out into the liquid and further removing the malt sprouts after the immersion step during the soluble extract preparation (p.17).

In regard to the recitation of producing "food or beverage without the unpleasant taste characteristic of malt sprouts" and unpleasant flavor in claims 31 and 20, it is noted that as stated above Todorova et al discloses controlled particle size of malt sprouts as recited and therefore meets the limitation of limited unpleasant flavor in the immersion step in claim 20. Further in regard to claims 31 and 20, it is noted that the malt sprouts are not the part of the final beverage product, the immersion liquid is. Todorova et al discloses further removing the malt sprouts after the immersion step

Art Unit: 1794

during the soluble extract preparation (p.17).Todorova et al discloses the use of malt sprouts extract in beer production as a partial substitute for malt extract in beer wort production because of the nutrient value of malt sprouts extract and because of the further efficient use of byproduct such as malt sprouts. (Abstract). Therefore, malt sprouts are not the part of the final beverage product. Further in this regard, it is noted that Todorova et al discloses beer production. It was well known in the art that in order to produce beer beverage a number of additional conventional steps should be employed, such as wort filtration, addition of hops to the wort, boiling of wort, cooling of wort, removal of precipitates from the cooled wort, aeration and addition of yeast to the wort, fermentation, removal of yeast, storage at low temperature to precipitate remaining yeast and polyphenols, filtration, etc. Therefore, the final beer product would be free of any unpleasant flavor or aroma associated with intermediate stages of beverage production. Further in this regard, Table 3 in Todorova et al shows that use of the immersion liquid in the production of beer wort balanced the amount of nitrogen in the resulting wort, but did not significantly effect the amounts of other components. Therefore, since Todorova et al discloses the use of malt sprouts extract in beer production as a partial substitute for malt extract in beer production, and since beer wort undergoes multiple production steps afterwards, and since Todorova et al shows that use of the immersion liquid in the production of beer wort balanced the amount of nitrogen in the resulting wort, but did not significantly effected the amounts of other components, Todorova et al meets the limitation associated with the taste of the final beer beverage.

Art Unit: 1794

In regard to claims 24-26 and 29, Todorova et al discloses production of beer beverage.

In regard to claim 25, it is noted that the recitation of the phrase “wherein the beverage product is an alcoholic beverage or a non-alcoholic beverage” only further characterizes the type of beverage product in the alternatively recited products of the preamble, and thus the claim is still anticipated by Todorova et al. Since claim 25 recites production of the food product, Todorova et al meets limitation of claim 25.

In regard to claim 26, it is noted that recitation of the phrase “wherein the alcoholic beverage is beer, happoshu (low-malt beer beverage), liquor, low-alcohol malt beverage, liqueur, whiskey or shochu” only further characterizes the type of beverage product in the alternatively recited products of the preamble, and thus the claim is still anticipated by Todorova et al. Since claims 26 recites production of the food product, Todorova et al meets limitation of claim 26.

In regard to claim 29, it is noted that recitation of the phrase “wherein the non-alcoholic beverage is a soft drink, a tea beverage or a milk beverage” only further characterizes the type of non-alcoholic beverage product in the alternatively recited products of the preamble, and thus the claim is still anticipated by Todorova et al. Since claims 29 recites production of the food product, Todorova et al meets limitation of claim 29.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21-30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todorova et al. in view of Yamamoto (JP 09-084540).

Todorova is taken as cited above.

In regard to claims 32 and 33, Todorova et al discloses the use of malt sprouts extract (i.e. immersion liquid) in beer production as a partial substitute for malt extract in beer wort production because of the nutrient value of malt sprouts and to more efficiently make use of a product (Abstract). In regard to the unpleasant taste recitation, Todorova et al is applied for the same reasons as discussed in the rejection as stated immediately above.

In regard to claims 21, 22, 32 and 33, which recites particle size smaller than 150µm and/or the surface area of the malt sprouts particles, Todorova et al is silent as to the grinding step.

Yamamoto discloses a process for producing food products, using malt sprouts of a controlled particle size (Abstract). Yamamoto discloses the process for producing food products, wherein the malt sprouts of controlled particle size are crushed at a low degree of crushing (Abstract, p. 3 Examples 1,2). In regard to claim 33, which recites particle size smaller than 150µm, Yamamoto discloses that particles are finely crushed by a crusher having 50-200 µm clearance (Abstract).

Todorova et al disclose employing the whole malt sprouts. Todorova et al disclose that extract of malt sprouts had high amino acid, metal ions, phosphorus content and vitamin B1 concentrations (Abstract). Todorova et al disclose “balancing beer must (wort) composition in regard to amine nitrogen content and other

Art Unit: 1794

components” by replacing part of malt extract in beer wort (Abstract). Crushing malt sprouts in order to increase surface area and decrease particle size would also increase extraction of desired components and would decrease the time of extraction. As evidenced by Yamamoto, it was well established to employ malt sprouts in the process of addition to a food product, wherein the malt sprouts are crushed or ground to a particular size within the recited limits. To modify Todorova and to employ ground malt sprouts of Yamamoto in the similar process would have been an obvious matter of choice. One of ordinary skill in the art would have been motivated to do so in order to increase extraction of desired components and to decrease time of extraction.

In regard to claims 33 and 22-23, Todorova et al does not specifically state the surface area and bulk density of the malt sprouts particles of the malt sprouts particles. As stated immediately above, to modify Todorova and to employ ground malt sprouts of Yamamoto in the similar process would have been an obvious matter of choice. Since Yamamoto discloses malt sprouts particles of the size as recited, the particular surface area and bulk density of the malt particles are seen to have been inherent result characteristics of crushing malt sprouts, and will depend on a particular particle size lacking any clear and convincing evidence and/or arguments to the contrary.

In regard to claims 24-26 and 29, Todorova et al discloses production of beer beverage. Further in regard to claims 24-26 and 29, Todorova et al is applied for the same reasons as stated in the rejection above.

In regard to claim 27, Todorova et al does not specifically disclose the amount of malt sprouts used. However, the amount of malt sprouts used is a result effective,

Art Unit: 1794

routinely determinable variable. Therefore, to vary amounts of malt sprouts depending on the desired nutritional and organoleptical profile of the final product would have been obvious.

In regard to claim 28, it is noted that recitation of the phrase “wherein the alcoholic beverage is beer, happoshu or low-alcohol malt beverage” only further characterizes the type of beverage product in the alternatively recited products of the preamble. In any case, since claim 28 recites production of the beer, Todorova et al meets limitation of claim 28.

Response to Arguments

The rejection of claims 16-29 under 35 U.S.C. 101 has been withdrawn due to the claims amendments filed 10/16/2009.

In regard to Applicants’ arguments regarding rejection of claims under 35 U.S.C. 112, second paragraph, Applicants are referred to the rejection as stated above.

The rejection of claims 16-17 and 21-30 under 35 U.S.C. 102(b) as being anticipated by Yamamoto (JP 09-084540) has been withdrawn due to the claims amendments filed 10/16/2009.

The rejection of claims 17-20 under 35 U.S.C. 103(a) as being unpatentable over Yamamoto (JP 09-084540) in view of Todorova et al has been withdrawn due to the claims amendments filed 10/16/2009.

Applicant's arguments filed 01/26/2009 regarding rejections of claims as being anticipated by Todorova et al and as being unpatentable over Todorova et al. in view of Yamamoto (JP 09-084540) have been fully considered but they are not persuasive.

On page 7 of the Reply to the Non-Final Office action mailed 09/25/2008, Applicants state that:

The summary of Todorova refers "possibilities for producing water soluble extract of malt sprouts." The method of extraction is not described and taste is not addressed. The method of extraction is likely to extract the bitter taste along with the amino acids and vitamins present in the malt sprouts. Extraction could use harsh chemicals or expensive enzymes like the extraction method described on page 2, lines 3-9 of applicants' specification. There is no discussion or production of an immersion liquid in the Todorova et al. summary, as required by the new and amended claims of the present application.

Examiner respectfully disagrees for the following reasons. The method of extraction is described in Todorova et al as recited in the new and amended claims: obtaining a collection of malt spouts of a controlled particle size, immersing the collection of malt sprouts in a liquid for a period of time to allow components of the malt sprouts to seep into the liquid thereby producing an immersion liquid and further using immersion liquid in the production of beer beverage (Abstract, p.17).

Further in response to Applicant argument that "The method of extraction is likely to extract the bitter taste along with the amino acids and vitamins present in the malt sprouts. Extraction could use harsh chemicals or expensive enzymes like the extraction method described on page 2, lines 3-9 of applicants' specification", it is noted that, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., use of

Art Unit: 1794

harsh chemicals or enzymes) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further in this regard, it is noted that there is no evidence that extraction as taught by Todorova et al simply by immersion of malt sprouts in the water would extract the bitter taste along with the amino acids and vitamins present in the malt sprouts.

Applicants merely state that “The method of extraction is likely to extract the bitter taste along with the amino acids and vitamins present in the malt sprouts”. Further in regard to the taste of the beverage product, and as stated in the rejection above, it is noted that the malt sprouts are not the part of the final beverage product, the immersion liquid is.

Todorova et al discloses further removing the malt sprouts after the immersion step during the soluble extract preparation (p.17). Todorova et al discloses the use of malt sprouts extract in beer production as a partial substitute for malt extract in beer wort production because of the nutrient value of malt sprouts and to more efficiently make use of a product (Abstract). Therefore, malt sprouts are not the part of the final beverage product. Further in this regard, it is noted that Todorova et al discloses beer production. It was well known in the art that in order to produce beer beverage a number of additional conventional steps should be employed, such as wort filtration, addition of hops to the wort, boiling of wort, cooling of wort, removal of precipitates from the cooled wort, aeration and addition of yeast to the wort, fermentation, removal of yeast, storage at low temperature to precipitate remaining yeast and polyphenols, filtration, etc. Therefore, the final beer product would be free of any unpleasant flavor or

Art Unit: 1794

aroma associated with intermediate stages of beverage production. Further in this regard, Table 3 in Todorova et al shows that use of the immersion liquid in the production of beer wort balanced the amount of nitrogen in the resulting wort, but did not significantly effect the amounts of other components. Therefore, since Todorova et al discloses the use of malt sprouts extract in beer production as a partial substitute for malt extract in beer production, and since beer wort undergoes multiple production steps afterwards, and since Todorova et al shows that use of the immersion liquid in the production of beer wort balanced the amount of nitrogen in the resulting wort, but did not significantly effected the amounts of other components, Todorova et al meets the limitation associated with the taste of the final beer beverage.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner, Art Unit 1794

/Vera Stulii/
Examiner, Art Unit 1794